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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,950	07/03/2003	William Warren	8172	2578
7590 08/17/2006 Woodling, Krost and Rust ( Kenneth L. Mitchell ) 9213 Chillicothe Road Kirtland, OH 44094			EXAMINER CECIL, TERRY K	
			ART UNIT 1723	PAPER NUMBER

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/613,950	<b>Applicant(s)</b> WARREN ET AL.	
	<b>Examiner</b> Mr. Terry K. Cecil	<b>Art Unit</b> 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 6-8-2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 8-25, 29-51 and 53-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 26-28, 52 and 60-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>one</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election *without* traverse of Group I, claims 1-7, 26-28, 60-63, and 52 in the reply filed on 10-15-2005 is acknowledged and has been made final.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

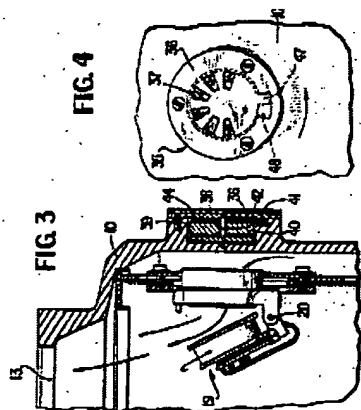
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Downey (U.S. 3,420,266). Downey discloses a filtration device including a filtering screen defining a chamber



within (figure 1) and a gate valve 19 positioned within the chamber. A tubular passageway defined by seat member 16 communicates between an outer surface of the filter and the chamber. The gate 19 swings between positions, wherein the position is indicated by the magnetically-actuated indicator (figure 4). It is the examiner's position that merely designating the

filtration device as a "water" filtration device or the filter as a "water" filter fails to further limit

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the structure thereof. In addition, it is pointed out that although Downey exemplifies a fuel filter, his invention is not limited solely thereto (see e.g. col. 1, lines 10-15).

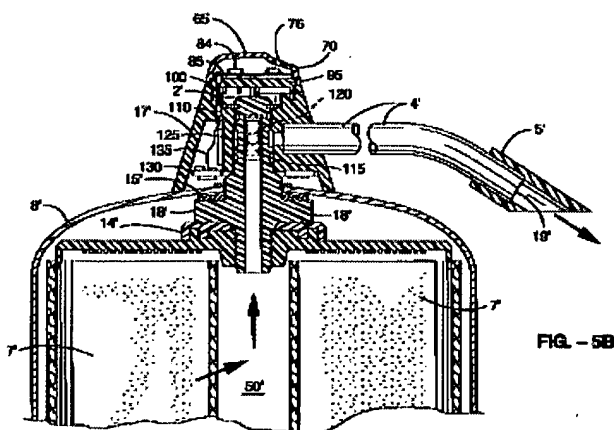
### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

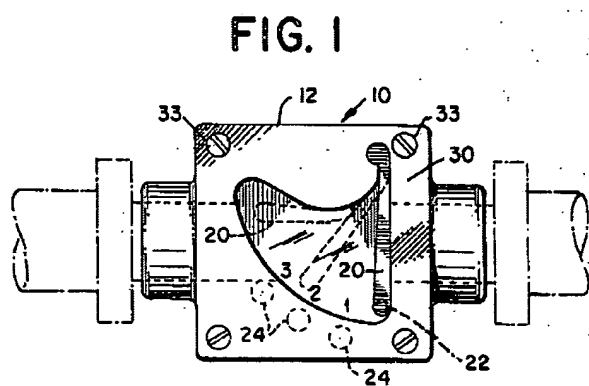


5. Claims 1-7, 26-27, 52 and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligman (U.S. 5,017,286) in view of Parise (U.S. 6,024,867) and Moore (U.S. 3,857,277). Heiligman teaches a water filtration device including a filter non-removably contained

within a housing that includes an end cap 48a. Heiligman doesn't teach a gate or gate position sensor. Parise discloses a water filtration device and filter performance indicator including a non-removable [as in claim 26] carbon-based filter 7 [as in claim 52] within a housing. The

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indicating device includes elements 115/125 responding to a magnetic field and an integrated circuit for calculating the total time water is flowing through the filter (col. 6, line 37) [as in claims 2-4 and 61]. The device also includes 3 LEDs indicate the remaining life of the filter [as in claims 5-7, 27 and 63]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the indicator of Parise in the invention of Heiligman, since Paries teaches the benefit of indicating filter life. Heiligman in view of Parise don't teach a gate that swings between positions and including a magnet affixed thereto. But such is taught by Moore. Moore teaches a flow indicating device including a gate 20



(swinging or rotating) having a magnet 22 attached thereto and means including reed switches 24 [as in claim 62] for detecting the positions of the gate [as in claims 1, 26 and 60].

It is considered that it would have been obvious to one ordinarily skilled in the art at the time of

the invention to have the indicating device of Moore in the outlet flow channel of the modified Heiligman, since Moore teaches the benefit of indicating a flow condition of *any fluid* that is designed for long-life and dependability and simplicity of construction that facilitates low-cost manufacture (col. 1, lines 15-22). Also it is pointed out that Parise is not limited to his shown ball configuration see e.g. the scope of his claim 1 and col. 6, line 33 which states that similar objects can be used (the examiner contends that the ball-shaped magnetic 22 within the flap 20 of Moore would be similar). It is also pointed out that Moore teaches that his switches can be connected to a circuit comprising an array of lamps. Upon modification all the limitations of

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claims 1-7, 52 and 60-63 are met (see also col. 6 of Parise). As for claim 26, the indicating device of Parise is considered to be in an end cap of the filter housing.

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligman in view of Parise and Moore, as applied to claim 27 above and in further view of Downey. Downey teaches a magnetically-actuated filter indicator that is part of a filter end cap (a side of the filter is also an end). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the filter end cap (elements 7b+18) of the modified Parise to include the hinged gate of Downey since Downey teaches the benefit of indicating a flow condition of a filter.

#### ***Response to Arguments***

7. Applicant's arguments filed 6-8-2006 have been fully considered but they are not persuasive.

- Applicant argues (page 15) that Downey doesn't meet the claim because he doesn't teach a passageway between the chamber and the filter but rather a passageway through the filter. As explained in the office action, the examiner considers the claimed chamber to be the space within and surrounded by the cylindrical filter media, and that the passageway is e.g. that defined by seat 32 (shown figure 5). The examiner contends that the passageway can extend through the filter media and still be between the filter and the chamber, as evidenced further by the flow configuration: when the filter is clogged such that the valve opens, fluid entering port 12 flow along and contacts the filter, flows through the passageway and into the chamber.

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- In response to applicant's argument that Downey doesn't specify that it is for filtering water, it is pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the examiner contends that regardless of the identity of the fluid flowing through the apparatus, the structure thereof has not changed.
- Applicant argues (page 17) that the examiner has not identified the claimed chamber nor the claimed passageway between the chamber and the filter. However, as cited in the action: it would have been obvious "to have the indicating device of Moore in the outlet flow channel of Parise". Upon modification of the flow channel 120 of Parise to include the indicating device (of figure 1) of Moore, the claimed passageway and chamber is taught, i.e. the passageway is the portion of the modified channel upstream of the flapper and the chamber is the portion of the modified channel downstream of the flapper.
- The examiner contends that since Moore's invention solves the problem of flow indication—the goal of Parise—sufficient motivation exists for combining the references. Despite applicant's remarks to the contrary, the examiner contends that regardless of the degree of rigidity of the flapper, such is properly considered to be swinging gate (a door that opens about an axis).
- Regarding the totalizing algorithm, the microprocessor totalizes the total flow through the apparatus.

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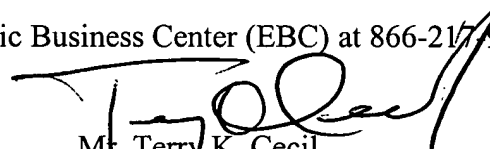
- Upon modification, the gate of Moore would be positioned within the end cap (that includes 7b + 18) of Parise.
- The flapper of Moore is a valve-type structure such that hinge teachings of Downey is relative thereto.



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8. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- Wanda Walker, the examiner's supervisor, can be reached at (571) 272-1151 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mr. Terry K. Cecil  
Primary Examiner  
Art Unit 1723

TKC  
August 15, 2006